FORMAL OBJECTIONS TO APPLICATIONS FOR PATENTS

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Formal Objections.

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Rule 34 following the Statute §4888 requires that the specification of an application for a patent shall be "in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains . . . to make, construct, compound and use the same," and the statute further requires that the applicant shall particularly point out and claim his invention. So the law requires that 300 or 400 of us perform continually the unwelcome task of censors. Obviously much the greater part of the work must be done by the assistant examiners, for the primary Examiner will rarely have occasion to act on questions of censorship unless they have been raised by an assistant. The assistants are left mainly to their own judgment in the matter, with little test of their judgment either by entrance or promotion examinations and with few decisions to promote uniformity and team-work. And so men are found taking almost every attitude from an easy-going ignoring of the Statute to that of the unnamed Examiner, who tradition says, wanted a case to be not only in good English, but in elegant English.

Let us consider from three points of view this duty of criticism, censorship, blue-penciling, revision, objection, playing schoolmaster, assisting applicants, or whatever one likes to call it.

1. What is involved in it.
2. How it may best be carried out.
3. What light do the decisions throw on our daily problems.

Start with the law of 1790, which states the purpose of the specification to be "to the end that the public may have the full benefit thereof after the expiration of the patent term." This makes clear the purpose to grant the patent, not in the inventor's interest, but for the public good, and because there is some new knowledge offered to the public. If this knowledge is offered in a foreign language, or in Miltonian English, or in a verbose, ungrammatical, incomplete or inaccurate way, its availability to the public is diminished or destroyed. So one of the duties of the Examiner is to look out for the public interest; and if the good-natured decision is quoted to him, "the largest latitude should be given to the applicant," he may make the very obvious reply—"the man who writes a passage can not judge whether it is clear so well as the man who reads it." A writer does not always know what his words will mean to another man, and they may not convey his real intent. In New York State, a century ago a deed conveying land had to be submitted to a magistrate for him to append a certificate to the effect "I have examined the above deed, and do approve it for record." An odious censorship some might say, but it probably ensured a valid deed, and defined the right of the grantee and those holding under him. Our responsibility is quite similar, but a thousand people may be interested in each application that leaves our hands for the Issue Division. Not one in a hundred of the patented cases ever reaches the courts, but every patent is read by many people whose time is wasted if we have passed a description which is not clear, concise, and exact.

In trying to find the limits of necessary or allowable criticism one limit is easily fixed—the standard of specification writing must not be set too high to be reached by thousands of inventors or their attorneys with a little help, and by hundreds of Examiners who have specialized in lines other than English prose composition.

It is clearly within proper limits to object to incorrect, ambiguous or misleading words, terms, or phrases, and where an art has recognized technical terms their use

should be required. There is no better brief characterization of a science than—a body of systematic knowledge having an accurate nomenclature; and any man responsible for using or for permitting the use with a broader or different meaning of terms having an established specific technical meaning in an art, shows a lack of the scientific spirit.

The limits are not so well defined regarding criticisms for clerical errors and lack of clearness; short-hand and rapid typewriting are responsible for many slips that any applicant would want to correct; rapid dictation produces wonderful, long passages whose beginning is forgotten before the period is reached; these of course should be broken up; sentences are sometimes incomplete and grammatical errors occur; proper punctuation, paragraphing, and hyphens to make compound words are often needed, for they are great aids to clearness. Although the Government Printing Office has published a seventy-page book of rules for the printing of patent specifications which prescribes minutely punctuation, paragraphing, abbreviations, and the spelling of hundreds of words, this editorial revision is not supposed to change the sense of a passage, and many sorts of errors can never be corrected by it.

Robinson says (II, p. 77):

> The description ought to be confined to three points: Attributes, Manner of Making, Mode of Use. Whatever matters of narration or assertion pass beyond these limits are surplusage and are at least unnecessary and objectionable. It is sufficient for persons skilled in the art, when construed as a whole. Description of each one of its three subjects-matter must be correct, complete, and intelligible (page 87). Description may not be intelligible, either because of its undue brevity or its excessive prolixity or the strangeness of its words or the confused arrangement of its sentences (page 91). If experiment or inventive skill on the part of the user is necessary the description is fatally ambiguous.

In view of the constant argument that the courts have sustained objectionable claims Commissioner Marble's statement must be remembered:

> "The fact that the courts will sustain patents in order to protect the rights of parties or that patents have been improperly issued, furnishes no Rule of action for this Office." 20 O. G., 1893.

But the courts do not always overlook defects; one judge says:

> "A very large part of the record consists of arguments in the form of depositions upon the true construction of Root's specification, and its sufficiency. They are able arguments; but a few lines of specification would have been worth them all." Root *vs.* Lamb, C. D., 1881, p. 191.

Examine now the various parts of the specification. The drawings may be criticized, first as to their sufficiency; the rules are explicit that they shall illustrate every feature claimed, and a decision requires that modifications or features described must be shown; on the other hand, the filing of an excessive number of sheets is an imposition on the applicant and the office. On the drawings, it is in accordance with the best practice to have the section lines numbered to agree with the figures; to have numerals used instead of letters where there are many of them, and to have them begin above the highest figure number; to have them come in strict order in the description and consecutively except for a break where the description passes from one part of a machine to another. Where letters are preferred, to avoid confusion there should not be used both capitals and small forms of c, o, v, x, y, z, and others that are nearly alike, and in musical cases, A to G should not be used for reference characters. Sometimes the characters are so irregular that a new specification and changes on the drawing are necessary. In one case having a very inconvenient though systematic notation, the Examiner was directed by the Commissioner to write the attorney

that any future cases with such notation would be returned.

Where a machine is at all complicated it is sometimes very helpful to have a diagrammatic figure, and arrows to show the directions of motion, and words defining parts or their location; often it is almost essential to have the work shown in its relation to the machine. In electrical cases, care should be taken to have as few crosses of conductors as possible; the distinction between branch-circuits and their common part should be clear; and the diagrams should not be mixed up with structure; a large share of the drawings of electrical musical instruments are defective in these respects when filed. Any unusual or striking feature on the drawing should be fully described.

A short title is required by the statute, though the word "short" is omitted in the Rules. Commissioner Simonds decision in *Ex parte* Nikola (C. D., 1891, p. 215), sustained the Examiner in objecting to an inaccurate title. The title should indicate the art, and preferably be rather specific; where there is a suitable trade name or office sub-class name it should be used. Any one who has ever tried to use the court set of patents furnished to various cities knows that the present annual indexes are almost worthless, since so large a proportion of the titles are unsuitable for indexing. For many years the Examiner was allowed to give an appropriate title when sending a case to issue, but this is no longer permitted.

The statement of invention should naturally give the reader a hint as to the special feature or improvement to be considered; it should show him in which direction to look. But very often it is a mass of verbiage without a single clear or useful idea—a bungling attempt to comply with the unfortunately worded requirement to state the "object and nature of the invention."

Where the description is long or complicated there should be at the beginning of each paragraph, a reference to the necessary figures; sometimes it is desirable to divide the matter into sections with center or side headings. It is generally clearer to have a straight-forward description of one form of the machine and its operation,

to be followed by the modifications and the enlarging clauses; for it is annoying to find such clauses scattered in every paragraph.

It may be worth while to note some common more or less objectionable expressions:

> "Associated" is indefinite and applies to articles on a shelf as well as to parts in a machine.
>
> "Correlated" would probably be unintelligible to the skilled workman by whose intelligence we are taught to test the disclosure.
>
> "Cam" for a wedge; "plane" in which a solid body lies or moves; "series" for two; "a number," when more than one is meant; "lever" for arm; "tension" for pressure or stress; "interlocking" for locking; "perpendicular" for vertical; "in unison" for simultaneously; "circuit" for a wire or part of a circuit; "between each;" "to progress" something; "to engage" x with y; "invention contemplates," although contemplation is the act of a mind. "Acceleration" is rarely used with its definite physical meaning.

The human body furnishes to the hard-pressed writer several more or less apt terms, as arm, finger, ear, nose, foot, etc.; but the recent discovery of a nose on a heel would startle an anatomist.

In the claims of course greater precision is needed and one must often object to such words as "designed," since it refers to a mental act, not to structure; "suitable," which is superfluous, for no one wants an unsuitable feature; "and" is often confusing, especially before "which" and before successive elements of a claim except the last one; "permit" is generally indefinite, for everything permits which does not prevent; "horizontal" is usually an idle limitation while "horizontally arranged" is often prolix and uncertain. "Member" or "portion" or "element" after a noun, as "cam" should usually be canceled, for it suggests only a fraction of the cam; "actuating means for the shaft" is ambiguous; "said" following "the" is, as Rogers (p. 96) says, generally unnecessary or tautological. Distributive words like "each," "corresponding," "respectively,"

are very often used indefinitely or ungrammatically. Time-clauses beginning "when" or "during" are often no more structural limitations than "'when the clock strikes ten" would be.

In recent patents are to be found "material distance," "apportionate," "in combination with x of y," I claim "to x, y, z," etc.

The word "adapted" covers more loose thinking and makes more trouble than any other word, though occasionally it is the best word for the place; where the parts are actually in combination it is mere surplusage to say they are adapted to join in combination; in such cases, the participial form is better than the infinitive—as "engaging," rather than "adapted to engage;" in Brown *vs.* Deere (61 F. R., 972), the Circuit Court of Appeals in holding a claim invalid, said "adapted to co-operate with" certain parts named was not synonymous with "combined with."

Preambles to claims beginning "in a machine," give much trouble. Commissioner Duell said in *Ex parte* Casler (1899):

> "Under the court decisions the introductory phrase is not an element of the combination and does not limit the claim to such apparatus."

Commissioner Allen held in *Ex parte* Gally (1908), that after the phrase "in a mechanism for moving self-playing music sheets" was prefixed, the claim was still for a mechanical movement and not for a combination of elements in a musical instrument. Yet neither Commissioner changed the example in the Rule-book, in which three out the four claims have the clause "in" etc. Probably a quarter of the claims printed in the Gazette, have the superfluous or deceptive phrase.

The use of singulars and plurals is often inconsistent either grammatically or logically; if one claims a plurality of X's and a Y co-operating with each X, whereas there is an equal plurality of Y's, then the claim is wrong and misleading and all the X's except one are idle elements.

Since a claim is not a complete sentence but is the object of the verb "claim," confusion sometimes arises where participles are used; thus "in a machine having

X, Y, Z, etc.," it is grammatically uncertain whether Y and Z are objects of the nearer verb "having" or the remoter one "claim." Such a claim may be treated as only a preamble; a recent Gazette has three patents with such claims which escaped attention.

The use of "means" defined by a function is too well established to need discussion even if the "means" includes several parts; but it may be noted that the recent decision in Lacroix *vs.* Tyberg, which restated this doctrine, was not due to any incorrect ruling of an Examiner. This doctrine however would not justify claiming a means serving two functions, where there are two devices and not a single unitary one; for instance, means for steering an auto and lighting the road.

It seems surprisingly difficult for some men to see the difference between a broad claim and a nebulous one; often a claim may be made clear and allowable by merely canceling an obscure clause, either functional or structural, even though it is thereby broadened.

The requirement that an applicant shall "distinctly claim . . . his invention" is glaringly violated constantly, first by prolix claims to which the Iagan decision (162 O. G., 538), applies; and second by an excessive number of claims; Commissioners and Judges have condemned such cases, but the only method of treating them furnished by Rules or decisions is by rejection under conditions that are so laborious as practically to leave the applicant full license to confuse the public. The words of Senator Christiancy some years ago apply here:

> "The very frequency of the abuse takes away the Commissioner's power of correcting it, and the greater the necessity for the correction becomes, the less is his power of correction."

A scale of fees graduated somewhat in proportion to the expense thrown on the Office and the difficulties put in the way of the public may be needed to reduce the evil.

When the Examiner has gone through the case, and noted all the objectionable passages, he has to decide which of them should be formally objected to and how the matter is to be put up to the applicant; at this point

personal equation and acquaintance with the attorneys count perhaps for more than anywhere else in office work; there are attorneys who welcome any assistance in putting a case in better shape and the briefest suggestion is enough; there are others who will respond only to a formal often-repeated requirement; who seem to care more for their words than for the protection secured; such men abuse the favor offered by Rule 64. Between these two classes are many who take the easiest way, and respond promptly to the objections. It is not a pleasant thing for anybody concerned to have a long letter full of criticisms in the file; sometimes this may be avoided by an oral suggestion that the case with Examiner's pencilings be looked over in the attorney's room; or by some general statement in a letter; e. g., this case needs thorough revision to correct obvious clerical errors and unusual terms.

One applicant's attitude of antagonism was changed on receipt of a letter directed by the Primary Examiner reading "the proposed changes were thought to be in applicant's interest, but as the Examiner will not have to defend the case in court, he need not insist on the objections."

It seems unnecessary in the first letter to make the objections in the way of a formal requirement; the phrase "should be changed" or "the following change is suggested" is perhaps more likely to bring the desired correction than "it is required;" further, a page may be clearer at 10 o'clock than at 4, and it is much easier to waive such an objection on a change of view or for reasons shown, or when the case is otherwise ready for issue; the second action will be soon enough to make a positive requirement. Other common forms of objections are: "the usual name for this part is," "preferably it should be called," "authority should be cited for this use of the word," "the word is not found in the dictionary," "the theory is believed to be unsound; certainly, it is not proved and it is unnecessary;" "this word is inapt or ambiguous or misleading throughout the case," "this passage is repetitious or obscure or does not assist in the disclosure of the invention or seems to be inconsistent

with another or with the drawing;" "the case will be improved by canceling or changing" so and so.

In a case badly presented it may be well for the Examiner to write compactly his understanding of the construction or operation and call on applicant to make substantially that statement, if it is correct. Where there is uncertainty as to an amended passage it is best to call for a statement of how the passage should read. It will often be necessary to call on applicant to identify some elements of a claim by reference characters in a letter (not in the claim).

In a long claim covering several groups of elements it is often helpful to separate the groups by semicolons or to indicate the groups by (a) (b) (c), etc. Where one finds difficulty in describing a structure correctly in broad terms it may be suggested to him to draw a very accurate specific claim and then broaden it element by element.

Some of the familiar decisions may be recalled here, such as:

> The preamble is not a limitation; an applicant may select his terms; a description of the operation should be added; the philosophy of an operation is not necessary; laudatory or derogatory statements, advertising, and theoretical matter, the history of the art, a catalogue of examples, the principles of law, unnecessary description and illustration and a statement of invention which is only a restatement of the claim, are all to be canceled. Parts referred to in the claim should be positively claimed. No ambiguous or useless word or phrase ought ever to be allowed in a claim.

The following words or expressions have been permitted by decisions:

> "Preferably" (inserted by amendment); "Make and break a toggle;" "Filament;" "Outlet," but not "opening;" "Stretcher;" "Means for marking," used of a stencil; "V-shaped;" "Longitudinally convexly curved;" "Or the like" in the preamble and "differential gear" in the claims.

In the MS. decisions of the last twelve or fifteen months the following are found:

One, requiring a sheet of drawing to be canceled and two, overruling the requirement;

Two, refusing entry of a substitute specification.

A requirement to limit number of sheets of drawings was overruled.

"While the Examiner has probably unnecessarily scolded the applicant, he has not gone beyond the bounds of propriety sufficiently to warrant the unusual action of canceling the paragraph objected to, and the petition must therefore be denied."

"The objections which the Examiner has taken to the specification . . . seem to me to be well taken excepting" certain of them.

"Claim 6 should have been rejected on the ground that the structure specified therein was not properly shown or the claim properly illustrated or the obscure feature properly described."

"This case has been pending a long time, and it would be to the interest of the public to pass it to issue."

"The Examiner wrote a letter making certain objections which on examination are found to be crude, to lack elucidation and to be at least partially erroneous." . . . "The office actions have not come up to the standard in these respects."

"The balls seem to be sufficiently positively included in claim 2, to warrant the allowance of this claim in its present condition and the petition is granted."

"There is no provision in the Rules for a request that the Examiner state why x and y are the same; applicant should point out wherein his claim avoids the reference instead of asking such questions."

"Applicant's specification is verbose and many of the phrases used by him are unintelligible, being apparently coined by applicant. . . . Examiner objected to specification as verbose and

containing inapt words and phrases and required that it should be rewritten in condensed form, and with the use of terms common in the art to which it appertains. . . . The specification should be couched in ordinary language and coined terms should not be used where it is possible to define the invention in ordinary language. Such terms as those only render the specification confused and indefinite."

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